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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,449	08/28/2000	Piotr Costa	017.38726X00	5441
20457	7590	12/06/2004	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889			LANIER, BENJAMIN E	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/648,449	COFTA, PIOTR	
	Examiner	Art Unit	
	Benjamin E Lanier	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 August 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 August 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment of claims 1, 9, 11, 12, 20-32 has been fully considered and is entered.

Response to Arguments

2. Applicant's arguments, see Amendment A, filed 23 August 2004, with respect to the rejection(s) of claim(s) 1-32 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Elliot, U.S. Patent No. 5,036,461.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 9 recites the limitation "said authenticating said control point" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 20 claims a method for authenticating a control point based on information received by the control point. These limitations render the claim indefinite because it is unclear how a token can authenticate a control point using information the token never receives. For the purposes of examination claim 20 will be treated using claim 1 limitations.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-32 are rejected under 35 U.S.C. 102(b) as being Elliott by U.S. Patent No. 5,036,461. Referring to claims 1, 8-11, 18-20, 22, 23, 28-32, Elliott discloses a transaction authentication system wherein transactions are performed between an IC card, and a terminal (Abstract, Col. 5, lines 11-57), which meets the limitations of authenticating an action between a control point and a user token. Before the transaction occurs the IC card, presented at the terminal, receives information from the terminal and authenticates the terminal using the received terminal information (Fig. 5 & Col. 8, line 14 – Col. 9, line 55), which meets the limitation of presenting a token which performs authentication to said control point and authenticating said control point using said token, obtaining information about said control point, authenticating said control point based on said information. The system contains a card reader interface for communication between the IC card and the terminal (Fig. 4, 44), which meets the limitation of a communication portion that obtains information regarding said control point and communicates with an external entity to authenticate said control point based on said information. The system contains a display, and a printer that provide information regarding the status of the transaction along with authentication status (Fig. 4, 48, 50), which meets the limitation of a user interface portion, coupled to said communication portion, to indicate a result of said authentication to a user.

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Referring to claims 2, 5, 12, 24, Elliott discloses card issuing organization that controls the manufacture and supplying of the IC cards (Col. 7, lines 5-14), which meets the limitation of a token issuer issuing said token to said user. The authentication and transaction process occur online with the card issuing organization (Col. 10, lines 20-35) which meets the limitation of authentication occurring on-line between said token and said token issuer.

Referring to claims 3, 4, 13-15, 25, 26, Elliott discloses a mobile interface for communication with the IC card (Fig. 4, 16).

Referring to claims 6, 16, Elliott discloses that the IC card is authenticated to the terminal before the transaction (Fig. 5, Col. 9, line 39 – Col. 10, line 35).

Referring to claims 7, 17, 27, Elliot discloses that the transactions are financially related (Col. 10, lines 26-29).

Referring to claim 21, Elliot discloses that the transaction terminals are used in retail stores, hotels, restaurants and banks (Col. 1, lines 12-16 & Col. 2, lines 39-40) where employees oversee the use of such terminals, which would meet the limitation of a control point operator approving said control point. Transaction terminal data and programming is stored at a site maintained under the separate control of each issuing organization (Col. 1, lines 60-64), which meets the limitation of storing data about said control point in a database.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Benjamin E. Lanier


THOMAS R. PEESO
PRIMARY EXAMINER